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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,698	02/08/2002	Dirk Muessig	7163-38	2519

21324 7590 11/17/2004

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EXAMINER	
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ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 11/17/2004

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/072,698
Filing Date: February 08, 2002
Appellant(s): MUESSIG ET AL.

Michael H. Minns
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 2, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's states in the brief that claims 1-8 and 17-46 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,178,346	Amundson et al.	1-2001
6,309,345	Stelzer et al.	10-2001
5,643,197	Brucker et al.	7-1997
6,079,414	Roth	6-2000
4,782,819	Adair	11-1988

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 rejected under 35 U.S.C. 103 as being unpatentable over Amundson et al. in view of Brucker et al. This rejection is set forth in numbered paragraph 2 of the prior Office Action, mailed on June 4, 2003.

Claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 are rejected under 35 U.S.C. 103 as being unpatentable over Stelzer et al. in view of Brucker et al. This rejection is set forth in numbered paragraph 3 of the prior Office Action, mailed on June 4, 2003.

Claims 2, 3, 7, 8, 19, 20, 23, 24, 27, 28, 31, 32, 35, 36, 39, 40, 43, and 44 are rejected under 35 U.S.C. 103 as being unpatentable over Stelzer et al. in view of Brucker et al. and

further in view of Roth et al. This rejection is set forth in numbered paragraph 4 of the prior Office Action, mailed on June 4, 2003.

Claims 4, 5, 17, 21, 25, 29, 33, 37, 41 and 45 are rejected under 35 U.S.C. 103 as being unpatentable over Stelzer et al. in view of Brucker et al. and Roth et al. and further in view of Adair et al.

(11) Response to Argument

As Appellant has established that all claims will rise and fall together, and since Appellant has submitted arguments with respect to the sole independent claim 1, this Examiner will limit the discussion of the prior art of interest with respect to the limitations recited in claim 1.

Obviousness of Amundson et al. in view of Brucker et al.

Beginning on page 7 of the Brief (and ending on page 8), Appellant accurately sets forth the position taken by the Office under 35 U.S.C. § 103(a) over Amundson et al. et al. in view of Brucker et al. It is clear from Appellant's arguments that there is no disagreement that Amundson et al. discloses a distal catheter portion, an illumination device, an image recording unit, and an image reproduction unit.

Appellant's first item of argument relies on the alleged teaching of Amundson et al. to use a "blood endoscope" (which is analogous to the limitations of claim 1 excluding the electrode and electrode line, consisting of the illumination device, the image recording unit and the image reproduction unit) with *existing separate* catheters (which in some cases include an electrode/electrode line). It is noted that none of the citations provided by Appellant in the first

full paragraph of page 8 of the Brief specifies that the catheters are separate from the viewing device (blood endoscope). However, for the purposes of argument and to eliminate this argument from being an issue, let us assume that Amundson et al. did specify the separateness of the viewing device and electrode catheter. Thus, Appellants issue now becomes: each and every element of claim 1, and namely an electrode positioned "on an imaging endoscope" (page 8, end of first full paragraph of Brief), is not disclosed by Amundson et al., whether in combination with Brucker et al. or not.

However, this Examiner must point out that claim 1 *does not require physical contact between the electrode and the elements which define the viewing device* (i.e., that the electrode is on the viewing device). Claim 1 recites **a distal catheter portion** and **an electrode on the distal catheter portion**. These limitations can clearly be met by an electrode catheter, as mentioned in Amundson et al. and also disclosed by Brucker et al. The elements required by the viewing device (endoscope) are the **illumination device**, the **image recording unit** and the **image reproduction unit**, none of which are described by the claim as being integral with or physically connected to the **distal catheter portion**. Note that the illumination device is given the function of *illuminating an area around* the distal catheter portion and the image recording device is given the function of *recording an image reflected by the area around* the distal catheter portion. Thus the illuminating device and image recording device are not necessarily physically connected with the distal catheter portion but could merely be separately positioned adjacent to such portion in order to perform the required functions.

Therefore, this Examiner takes the position that whether Amundson et al. refers to separate instruments or not is moot in view of the fact that claim 1 does not specifically require such limitation.

At this point, some or all of the members of the Board might be wondering why Amundson et al., in view of the position taken above, was not applied as an anticipatory reference since Amundson et al. expressly suggests (which Appellant openly admits) use of an endoscope with certain catheters that are known to include an electrode at the distal end which is capable of functioning as claimed (electrical mapping and electrophysiogic catheters, both of which are specifically mentioned by Amundson et al., include electrodes that are capable of delivering an electrical signal to body tissue and receiving an electrical signal from body tissue). This Examiner can not answer such question since he was not the author of the Final Office Action.

However, it would appear that the former Examiner was concerned about the scarcity of description of the numerous electrode catheters that were nominally recited by Amundson et al. Claim 1 calls for "wherein the catheter is in the form of an electrode line, with an electrode on the distal catheter portion, the electrode being adapted for at least one of: delivering an electrical signal to body tissue adjoining the distal catheter portion and receiving an electrical signal to body tissue adjoining the distal catheter portion". None of the electrode catheters mentioned by Amundson et al. are described with such detail. Even when electrodes are mentioned in Amundson et al., as they are in column 9, lines 10-11, the electrode line (e.g., wire) is not[1].

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[1] Although there is a possible issue of inherency with respect to whether a electrode line would necessarily be required in combination with an electrode, this position was not set forth in the Final Office Action and will therefore not be address here.

Since Amundson et al. (at col.3, lines 46-53 and cited by the outstanding rejection) mentions that the electrode catheters could be ones used in electrical mapping and catheter ablation, it is the position taken by this Examiner that the former Examiner correctly supplied evidence that such specific-use catheters include at least an electrode line, an electrode at the distal catheter portion and wherein the electrode is adapted for at least one of: delivering an electrical signal to body tissue adjoining the distal catheter portion and receiving an electrical signal to body tissue adjoining the distal catheter portion (note in Brucker et al. a distal catheter portion as including an electrode (26) and electrode line (electrical connection means described in col.5, lines 8-14), wherein the electrode can be used for ablation and/or electrophysiological mapping (col.5, lines 34-57)).

In conclusion of this issue, the Examiner takes the position that although the claim does not exclude separate instruments (i.e., viewing device and electrode catheter), Amundson et al. indeed suggests use of the combination of such instruments, wherein Brucker et al. was only relied upon to evidence one example of the details of an electrode catheter. Thus the prior art as a whole expressly teaches each and every element of claim 1.

With respect to Apellant's additional argument regarding that there was no suggestion in Amundson et al. to combine the disclosures (second full paragraph of page 8 of the Brief), as pointed out above by the Examiner and pointed out by Appellant in the first full paragraph of page 8 of the Brief, Amundson et al. clearly and expressly suggests use of the viewing device in combination with certain specific-use catheters, including the ones similarly disclosed by Brucker et al. Amundson et al. specifically teaches the link to the teachings of Brucker et al. and

the motivation to ascertain the needed electrode catheter structure that was apparently lacking in Amundson et al.

It is noted that Appellant's argument that the Examiner made "only broad conclusory statements about the motivation in Amundson and Brucker" (third full paragraph of page 8 of the Brief) is only allegedly supported by a list of case law and that no evidence that the Examiner's statements fit such a mold is provided.

Obviousness of Stelzer et al. in view of Brucker et al.

Beginning on page 9 of the Brief, Appellant accurately sets forth the position taken by the Office under 35 U.S.C. § 103(a) over Stelzer et al. in view of Brucker et al. It is clear from Appellant's arguments that there is no disagreement that Stelzer et al. discloses a distal catheter portion, an illumination device, an image recording unit, and an image reproduction unit

To clarify what each reference teaches with respect to any kind of electrodes: Stelzer et al. teaches use of an electrocautery wand (called a "wand" but clearly would have to include an electrode) as in column 6, line 67 and column 11, lines 1-8, which inherently is for providing a high energy current for ablation. Brucker et al. teaches an ablation/cautery catheter, which includes an electrocautery electrode, and which additionally and concurrently includes an electrode for applying and receiving electrical signals. This latter electrode having the structure which meets the limitations of the electrode of Appellant's claim 1.

Notwithstanding the fact that an ablation/electrocautery electrode might inherently be capable of delivering or receiving an electrical signal[2] which would make Stelzer et al. an anticipatory reference, it appears that the former Examiner saw a lacking the Stelzer et al. reference with respect to the electrode structure and/or function. Brucker et al. was used to fill the void with that of which is within the level of ordinary skill.

Appellant argues that "Absent the teaching of Applicant's disclosure, Stelzer does not suggest or motivate one skilled in the art to combine the imaging endoscope teachings of Stelzer with the catheter electrode teachings of Brucker". Although this may be true, it is clear from the outstanding rejection that the motivation to use such an expanded use electrode device (ablation/cautery *and* monitor/measuring function of Brucker) in place of the generic electrode device of Stelzer (ablation/cautery only) comes from the Brucker et al. reference. Appellant did not even attempt to explain why the teachings of Brucker et al. would **not** motivate one of ordinary skill in the art to use an electrode device of Brucker et al. in the Stelzer et al. device.

Furthermore, Appellant argues that the motivation given by the Examiner to combine the teachings of Stelzer et al. and Brucker et al. are "broad conclusory statements". The Brucker et al. reference clearly and particularly pointed out that using the ablation/monitoring electrode device would add the capability for measuring potentials in biological tissue which would be useful in analogous ablation procedures (last paragraph on page 5 of the Final Office Action). This Examiner takes the position that such motivation can not get any more specific.

Therefore, since Appellant really did not point out any supposed errors in the Stelzer et al./Brucker et al. rejection, and a position is taken that a *prima facie* case of obviousness has

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[2] Again the former Examiner did not raise the issue of a single electrode being capable of both

been established, this Examiner takes the position that claim 1 would have been obvious over Stelzer et al. in view of Brucker et al.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John P. Leubecker
Primary Examiner
Art Unit 3739

jpl
November 12, 2004

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electrocautery functions and signal delivering/receiving functions so this Examiner will not.